OPE 1400.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Application of

WILLIAM N. DAVIS ET AL

APPEAL No.

U.S. Serial No. 10/621,275

Group Art Unit 2178

Filed: July 17, 2003

Examiner: D. Faber

FONT RENTAL SYSTEM AND METHOD

Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450

Dear Sir:

Transmitted herewith is the Appeal Brief in the above-identified application.

- X Appeal Brief fee enclosed of \$250.00 /\$500.00.
  Small entity status of this application has been established.
- \_\_\_\_ This Appeal Brief is being filed within the period set for filing.
- X Appellant(s) hereby petition for an extension for filing this Appeal Brief as follows:

First-Month Extension			
Second-Month Extension	\$ 225.00	/ \$	450.00
X Third-Month Extension	\$ 510.00	/ \$	1020.00
Fourth-Month Extension	\$ 795.00	/ 5	1590.00

A check in the amount of  $\frac{1,520.00}{}$  is attached hereto.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-3690 of the undersigned attorney. A duplicate copy of this sheet is enclosed.

85/30/2007 SZEUDIE1 00000020 10621275

Respectfully submitted,

1620.00 OP

Mary J. Breiner, Reg. No. 33,161

Attorney of Record

Date: May 29, 2007 Telephone (703) 684-6885 OPE HASI

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Alexandria, Virginia May 29, 2007

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# BRIEF ON APPEAL

Dear Sir:

This appeal is from the action of the Primary

Examiner mailed June 28, 2006 rejecting claims 1-6, 10, 11,

13, 14 and 17-21.

Appellants' brief fee of \$500 is attached. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-3690 of the undersigned attorney.

ช5/30/2007 SZEUDIE1 80000020 10621275 ช2 FC:1402 500.00 OP

# Real Party in Interest

The captioned application is assigned in its entirety to Monotype Imaging, Inc., a corporation organized under the laws of Delaware, located in Woburn,

Massachusetts.

# Related Appeals and Interferences

No appeal or interference is known to appellants which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

#### Status of Claims

The claims pending in this application are claims 1-6, 10, 11, 13, 14 and 17-21. Claims 1-6, 10, 11, 13, 14 and 17-21 are rejected. Claims 7-9, 12, 15-16 and 22-24 have been canceled. Accordingly, the appealed claims are 1-6, 10, 11, 13, 14 and 17-21 as set forth in the Appendix hereto.

# Status of Amendments

A timely response was made on November 29, 2006 to the final official action mailed June 28, 2006. No amendment was proposed in the response.

## Summary of Claimed Subject Matter

Independent claim 1 claims a method for the distribution of fonts by rental, the method comprising:

a font consumer requesting a font from a font provider; (page 4, line 11)

the font provider accessing subscription information for the font consumer (page 4, line 12);

the font provider sending the requested font to the font consumer depending on the subscription information (page 4, lines 12-13; page 8, lines 8-11), the font provider giving lifetime information with the requested font, the lifetime information defining a predetermined period of time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information (page 4, line 25 to page 6, line 2; page 8, lines 3-4); and

the font consumer receiving the requested font and providing the requested font to an application by installing the requested font in the font consumer for the predetermined period of time and for the predetermined access, wherein the required font is tracked so that upon expiration of said predetermined period of time, the font is disabled (page 4, lines 14-16; page 6, line 3; page 9, lines 24-26).

Independent claim 11 claims a system for managing fonts by rental on a computer, comprising:

a font request interceptor receiving demands for fonts from applications running on the computer (page 5, lines 6-7; page 9, lines 9-12);

a font retriever for requesting the demanded fonts from a remote font provider if the demanded fonts are not installed on the computer, the font retriever providing subscription information to the remote font provider (page 5, lines 7-9);

a font installer for receiving and installing the demanded fonts (page 5, line 9; page 9, lines 13-17); and

a font tracker for monitoring and controlling use of the demanded fonts by the applications in response to privilege information received from the remote font provider (page 5, lines 10-11), said privilege information defining a predetermined time period of use and a predetermined use access, and wherein the font tracker disables the demanded font after expiration of said predetermined time period (page 9, lines 18-26).

Independent claim 18 claims a method for the distribution of fonts by rental, the method comprising:

a font consumer requesting a font from a font provider and providing payment for the font based on subscription

information defining a specified time period of use and a specified use access (page 5, lines 13-14);

the font provider sending the requested font to the font consumer along with a license for the font consumer that enables the font consumer to use the font for the specified time period and the specified use access (page 5, lines 14-16; page 8, lines 1-4); and

the font consumer receiving the requested font and providing the requested font to an application for the specified period of time at the specified use access (page 5, lines 16-17), wherein upon expiration of said specified time period, the requested font is disabled (page 9, lines 24-26).

## Grounds of Rejection to be Reviewed on Appeal

The grounds of rejection of the present appeal are:

- A. Whether claims 1-3, 6, 10 and 18-20 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,853,980 (Ying) in view of U.S. Patent No. 6,882,344 (Hayes);
- B. Whether claim 4 is patentable under 35 U.S.C.§103(a) over Ying in view of Hayes and further in

- view of U.S. Patent Application Publication No.
  2003/0119478 (Nagy);
- C. Whether claims 5 and 21 are patentable under 35 U.S.C. §103(a) over Ying in view of Hayes and further in view of U.S. Patent Application Publication No. 2001/0042124 (Barron);
- D. Whether claims 11, 13 and 17 are patentable under 35 U.S.C. §103(a) over Hayes in view of Ying; and
- D. Whether claim 14 is patentable under 35 U.S.C. §103(a) over Hayes in view of Ying and further in view of Barron.

#### Argument

The pending claims are 1-6, 10, 11, 13, 14 and 17-21, wherein claims 1, 11 and 18 are the independent claims.

I. Rejection of Claims 1-6, 10-11, 13-14 And 17-21 Under 35 U.S.C. §103(a)

The invention as claimed is directed to methods and systems for font rental. The claimed methods and systems are distinct from conventional methods and systems of purchasing or licensing fonts on a permanent or perpetual basis, as well as distinct from a sample of a font provided as a preview or "taste" to induce purchase of the font on a

perpetual basis. Appellants claim methods and systems which provide, among other things, for control of the degree to which an end user can access the font and how long the font is available to the user. "Rent" by definition, Webster's Seventh New Collegiate Dictionary, page 726 (1969) (attached in the Evidence Appendix) refers to an owner granting possession and use of property in return for some fixed Thus, by renting a consumer, in return for payment, controls the terms of time and degree of use so as to allow completion of a desired job. Cost to the end user therefore, can be reasonable since the user is not required to purchase more than what is needed. The enforcement of the limited term of the rental is part of the methods and systems of the invention (see the specification at page 4, lines 4-9). Claims 1, 11 and 18 set forth that a requested font is provided for a predetermined period of time and for a predetermined use access based on subscription information provided by a font consumer, that the requested font is tracked so that the time and use of the requested font conforms to the predetermined period of time and access, and that the requested font is disabled upon expiration of the predetermined period of time. The applied art does not teach or suggest appellants' claimed methods and systems.

applied as to independent claims 1, 11 and 18. Nagy is applied (in combination with Ying and Hayes) only in relation to the added limitation of dependent claim 4.

Barron is applied (in combination with Ying and Hayes) only in relation to the added limitation of dependent claims 5, 14 and 21. Appellants respectfully submit that the primary references of Ying and Hayes do not render independent claims 1, 11 and 18 obvious within the meaning of 35 U.S.C. §103. Further, appellants submit that the secondary references do not make up for the shortcomings of Ying and Hayes.

The Examiner acknowledges at page 5 of the June 28, 2006 office action that Ying fails to disclose that the required font is tracked so that upon expiration of the predetermined time period, the font is disabled but relies on Hayes for this teaching. At page 11 of the June 28, 2006 office action, the Examiner further acknowledges that Hayes fails to specifically disclose providing information defining a predetermined time period of use where the font tracker disables the demanded font after expiration of the predetermined period of time. In the Advisory Action mailed December 20, 2006, the Examiner asserts that "while Ying et al fails to disclose renting a desired font for a

predetermined period of time and access" that Hayes does disclose it and as support refers to column 8, lines 46-50 wherein Hayes describes providing a "sample" of a font to a potential purchaser. The Examiner then goes on to equate, without support, "renting" with "borrowing" or "lending" of a font. Appellants disagree that such are the same and do not take into consideration all features of the claimed methods and systems and, thus, the combined art fails to render the claimed invention obvious within the meaning of 35 U.S.C. §103.

More specifically, Ying does not teach a method or system for distributing or managing fonts by rental involving the combination of features as claimed by appellants. Ying provides no description as to how to provide or implement or enforce a license or sale including limitations. Appellants claim particular methods and systems for distributing or managing fonts specifically on a rental basis.

Hayes describes a system and method for examining font files for corruption. To the extent Hayes describes sale of fonts, such involves the sale of a group of fonts or individual fonts. The sale may include a sampling period so that a user can sample a font prior to purchase. However, thereafter the user is prompted to purchase the font. A

method or system for renting a desired font for a predetermined period of time and access is not described. Only a preview and purchase system, i.e., a sales system, is described. A preview or sampling by its nature provides a limited "taste" or use of the article of commerce sought to It is limited so that a complete access or use is not provided or available, otherwise the sought after object of a sale of the article is voided, which as taught by Hayes is the sale of fonts. As set forth above, "rent" by definition is distinct from a "sample" or "preview" since renting is based on the needs or terms of a subscriber in return for payment to the owner. The claimed methods and systems provide specific features in order to carry out renting of a font that is not taught or suggested by Hayes. Further, applicants submit that the modification necessary to the teaching of Hayes to obtain the claimed methods or systems is beyond the teaching or suggestion of Ying or Hayes.

More specifically, the claims provide for accessing or providing subscription information which determines the predetermined period of access for use of the fonts. This time period, as claimed, allows for the provision and installing of a requested font by the consumer and use of the font by the consumer. Accordingly, the

claimed methods and systems have a different purpose and are defined by specific features to achieve that purpose that are not taught or suggested by Ying or Hayes.

For a proper rejection, the invention as claimed must be determined to be obvious from a fair reading of the prior art as a whole and requires a comparison of the subject matter claimed with the prior art as a whole. In re Gordon, 221 USPQ 1125, at 1127; In re Rothermel and Waddell, 125 USPQ 328, at 331-332; and <u>In re Aufhauser</u>, 158 USPQ 351, at 353. In the case at hand, there is nothing in the individual references which suggests the specific combination of the claimed methods and systems for font rental. A rejection under 35 U.S.C. §103 must rest on a firm factual basis and deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupportable generalities. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and <u>In re Freed</u>, 425 F.2d 785, 165 USPQ 570 (CCPA 1970), or applicants' teaching. Further, KSR International Co. v. Teleflex Inc. et al, 550 U.S. \_\_\_\_, 82 USPQ2d, 1385, 1396 (US SupCt 2007) states, citing <u>In re</u> Kahn, 441 F.3d 977, 988 (CA Fed. 2006) that "rejections on obviousness grounds cannot be sustained by mere conclusionary statements; instead there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness." The Examiner has not even shown that each of the isolated elements, much less the combination, are known in the prior art.

Accordingly, Hayes and Ying do not render the claimed methods and systems for font rental obvious within the meaning of 35 U.S.C. §103.

As set forth above, Nagy is applied solely with respect to the limitation of claim 4 as to debiting an account of a consumer and Barron is applied solely with respect to the limitation in dependent claims 5, 14 and 21 as to encrypting or decrypting a font. Nagy provides no teaching or suggestion as to a method or system for distributing or managing fonts on a rental basis as claimed by appellants. Further, Barron provides no teaching or suggestion as to a method or system for distributing or managing fonts on a rental basis as claimed by appellants. Thus, neither Nagy nor Barron make up for the shortcomings of Ying and Hayes and, therefore, do not teach the claimed methods and systems.

Accordingly, appellants respectfully submit that the applied references do not suggest the claimed invention within the meaning of 35 U.S.C. §103.

# Conclusion

It is respectfully submitted that the appealed claims are patentable within the meaning of 35 U.S.C. §103. Reversal of the Examiner's rejection is, therefore, respectfully urged.

Respectfully submitted,

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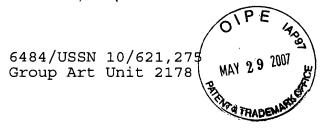
Telephone: (703) 684-6885

Attachments - Claims Appendix

- Evidence Appendix With Attachment

- Related Proceedings Appendix

- \$500.00 Brief Fee



# The Appealed Claims:

A method for the distribution of fonts by rental,
 the method comprising:

a font consumer requesting a font from a font provider; the font provider accessing subscription information for the font consumer;

the font provider sending the requested font to the font consumer depending on the subscription information, the font provider giving lifetime information with the requested font, the lifetime information defining a predetermined period of time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information; and

the font consumer receiving the requested font and providing the requested font to an application by installing the requested font in the font consumer for the predetermined period of time and for the predetermined access, wherein the required font is tracked so that upon expiration of said predetermined period of time, the font is disabled.

2. A method as claimed in claim 1, wherein the step of the font consumer requesting the font from the font provider comprises:

the font consumer accessing a web site of the font provider;

the font consumer logging onto the web site; and the font consumer identifying the requested font.

3. A method as claimed in claim 1, wherein the step of the font provider accessing the subscription information for the font consumer comprises:

accessing a subscriber database;

looking up the font consumer in the subscriber database; and

reading font privileges associated with the font consumer.

- 4. A method as claimed in claim 3, wherein the step of the font provider accessing the subscription information for the font consumer further comprises debiting an account of the font consumer.
- 5. A method as claimed in claim 1, wherein the step of the font provider sending the requested font to the font consumer comprises:

the font provider encrypting the font prior to transmission to the font consumer.

6. A method as claimed in claim 1, wherein the step of the font provider sending the requested font to the font consumer comprises:

the font provider giving privilege information with the font, the privilege information defining approved uses for the requested font by the font consumer.

- 10. A method as claimed in claim 1, wherein in the step of the font consumer receiving the requested font,
- the installing of the requested font occurs in random access memory of the font consumer.
- 11. A system for managing fonts by rental on a computer, comprising:
- a font request interceptor receiving demands for fonts from applications running on the computer;
- a font retriever for requesting the demanded fonts from a remote font provider if the demanded fonts are not installed on the computer, the font retriever providing subscription information to the remote font provider;
- a font installer for receiving and installing the demanded fonts; and
- a font tracker for monitoring and controlling use of the demanded fonts by the applications in response to privilege information received from the remote font provider, said privilege information defining a predetermined time period of use and a predetermined use access, and wherein the font tracker disables the demanded font after expiration of said predetermined time period.

- 13. The system as claimed in claim 11, wherein the font retriever accesses a web site of the font provider and logs onto the web site to be identified by the font provider.
- 14. The system as claimed in claim 11, wherein the font retriever decrypts the demanded font.
- 17. The system as claimed in claim 11, wherein the font installer installs the demanded font into random access memory of the font consumer.
- 18. A method for the distribution of fonts by rental, the method comprising:
- a font consumer requesting a font from a font provider and providing payment for the font based on subscription information defining a specified time period of use and a specified use access;

the font provider sending the requested font to the font consumer along with a license for the font consumer that enables the font consumer to use the font for the specified time period and the specified use access; and

the font consumer receiving the requested font and providing the requested font to an application for the specified period of time at the specified use access, wherein upon expiration of said specified time period, the requested font is disabled.

4 10 3

- 19. A method as claimed in claim 18, further comprising the font provider accessing the subscription information for the font consumer.
- 20. A method as claimed in claim 18, wherein the step of the font consumer requesting the font from the font provider comprises:

the font consumer accessing a web site of the font provider;

the font consumer logging onto the web site; and the font consumer identifying the requested font.

21. A method as claimed in claim 18, wherein the step of the font provider sending the requested font to the font consumer comprises:

the font provider encrypting the font prior to transmission to the font consumer.

\* \* \* \* \*

E V I D E N C E A P P E N D I X -1-

(1) Page 726, Webster's Seventh New Collegiate Dictionary (1969) - Definition of "rent".

\* \* \* \* \*

# Webster's Seventh New Collegiate Dictionary

a Merriam-Webster

BASED ON
WEBSTER'S
THIRD
NEW INTERNATIONAL
DICTIONARY



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#### rencounter

## 726

#### reparation

'kaûnt-or\ n [rencounter fr. MF rencontre, fr. rencontrer; rencounter fr. F] 1: a hostilic meeting or a contest between forces or individuals : COMBAT 2: a casual meeting rencounter v [MF rencontrer to meet by chance or in hostility, fr. re- + encontrer to encounter]: to meet casually rend \'rend\' vb rent \'rent\' also rend-ed; rend-ing [ME renden, fr. OE rendan; akin to OFTs renda to tear, Skt randhra hole] vi 1: to remove from place by violence: wrest 2: to split or tear apart or in pieces by violence 3: to tear (the hair or clothing) as a sign of anger, grief, or despair 4 a: to lacerate with painful feelings b: to piece with sound c: to divide (as a nation) into parties ~ vi 1: to perform an act of tearing or splitting 2: to become torn or split syn see Tear

Iren-der \'ren-dor\' vb ren-der-ing \-d(-)-rio\\ [ME renden, fr. MF rende to give back, yield, fr. (assumed) VL rendere, alter. of L reddere, partly fr. re- + dare to give & partly fr. re- + dere to put — more at DATE, Dol vi 1 &: to melt down: Tray b: to treat so as to convert into industrial faits and oils or fertilizer 2 a: to transmit to another: DELIVER b: to give up: YiELD 0: to furnish for consideration, approval, or information: as (1): to hand down (a legal judgment) (2): to agree upon and report (a verdict) 3 a: to give in return or retribution b (1): to give back: RESTORE (2): REFLECT, ECHO 0: to give in acknowledgment of dependence or obligation: PAY d: to do (a service) for another 4 a (1): to cause to be of become: MAKE (2): IMPART b(1): to reproduce or represent by artistic or verbal means: DEPLICT (2): to give a performance of (3): to produce a copy or version of (4): to execute the motions of (~a saiute) 6: TRANSLATE 6: to diete the execution of: ADMINISTER (~ justice) 6: to apply a coat of plaster or cement directly to ~ vi: to give recompense — ren-der-able \-(-(2)-17-bol) ad/ — ren-der-or\-(-d--or\-n) n

Iren-der n: a return esp. in kind or services due from a feudal tenant to his lord

Iren-deyous \( v''': to bring together at a r

1.12

18-18-80-18-118 \,re-ni-go-sale-yo-s\ asy, subject to recover then re-ne-go-ti-ate \,re-ni-go-sale-yo-s\ asy, subject to recover excessive profits -- re-ne-go-ti-a-tion \,re-ni-go-s(h)ē-ā-shon\ n re-new \,ri-n(y)\ll\ vi 1 : to make new again; also : to gain again as new 2 : to make new spiritually : REGENERATE 3 : to restore to existence : Revive 4 : to do again : REPEAT 5 : to begin again : RESUME 6 : REPLACE 7 : to grant or obtain an extension of or on - vi 1 : to become new or as new 2 : to begin again : RESUME 3 : to make a renewal -- re-new-abil-i-ty \,ri-n(y)\ll-3-bil-3t-\ll\ n - re-new-abil-\,ri-n(y)\ll-3-bil-3t-\ll\ n - re-new-abil-\,ri-n(y)\ll\ n - re-new-a

v/ 1: to give up, refuse, or resign usu, by formal declaration (~ his errors) 2: to refuse further to follow, obey, or recognize: REPUDIATE 3: to fail to follow with a card from (the suit led) ~ vi: to make a renounce or renunciation syn see ABDICATE, ABJURE — re-nounce-ment \-'naun(t)-sman( n — re-nounce-r n 276-nounce \ri-'naun(t)s, 'rê-,\ n: failure to follow suit in a card game

game
ren.o.vate \ren.o.vat\ vt [L renovatus, pp. of renovare, fr. re-+
novare to make new, fr. novus new — more at New] 1: to restore
to life, vigor, or activity: Revive 2: to restore to a former state
syn see Renew — ren.o.va.tion \, renomer \, renomer to
celebrate, fr. re- + nomer to name, fr. L nominare, fr. nominnomen name — more at NAME] 1: a state of being widely acclaimed
and highly honored: FAME 2 obs: REPORT, RUMOR

169-nown (1'-naun) n [ME, fr. MF renon, fr. OF, fr. renomer to celebrate, fr. re. + nomer to name, fr. L. nominare, fr. nomin-nomen name — more at NAME] 1; a state of being widely acclaimed and highly honored: rAME 2 ob: REPORT, RUMOR
7 renown w! to give renown to fe.nowned and highly honored: rAME 2 ob: REPORT, RUMOR
7 renowned ad: having renown: CELEBRATED Syn see PAMOUS
7 renowned ad: having renown: CELEBRATED Syn see PAMOUS
7 renowned ad: having renown: CELEBRATED Syn see PAMOUS
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7 renowned take of the control of the control of renowned to feel and the control of renowned to feel and the control of renowned to feel and the feel and

-man n a : the act or process of repairing b: an instance or result of repairing c: the replacement of destroyed cells or tissues by new formations 2 a: relative condition with respect to soundness or need of repairing b: the state of being in good or sound condition

condition

10-pand \rl-'pand\ adj [L repandus bent backward, fr. repandus bent; akin to ON jattr bent backward]: having a slightly
undulating margin (a ~ leaf)

10-a-ra.ble \'rep-(a-)-ra-bal\ adj: capable of being repaired

10-a-ra.tlon \rep-a-ra-shan\ n [ME, fr. MF, fr. LL reparation,
reparatio, fr. L reparatus, pp. of reparare] 1 a: a repairing or
keeping in repair b pl: Repairs 2 a: the act of making amends,
offering expiation, or giving satisfaction for a wrong or injury
b: something done or given as amends or satisfaction 3: the
payment of damages: INDEMNIFICATION; specif: compensation in
money or materials payable by a defeated nation for damages to or
expenditures sustained by another nation as a result of hostilities
with the defeated nation — usu, used in pl.

reorientation repack

R E L A T E D
P R O C E E D I N G S
A P P E N D I X
-1-

None.

\* \* \* \* \*